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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,426	11/03/2003	Lauren D. Johnson	047255-5003-US	6494

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EXAMINER	
ROBINSON, KEITH O NEAL	
ART UNIT	PAPER NUMBER
1638	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/698,426	JOHNSON ET AL.	
	Examiner	Art Unit	
	Keith O. Robinson, Ph.D.	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-31* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, and 30, drawn to an alfalfa plant, classified in class 800, subclass 295, for example.

II. Claims 22 and 27, drawn to a method of producing alfalfa plants with detectable levels of condensed tannins by identifying said plants and crossing said plants with other alfalfa plants, classified in class 800, subclass 260, for example.

III. Claims 23 and 25, drawn to alfalfa germplasm designated CW 28061 and regenerable cells of said germplasm, classified in class 800, subclass 298, for example.

IV. Claims 24 and 26, drawn to alfalfa germplasm designated CW 29053 and regenerable cells of said germplasm, classified in class 800, subclass 298, for example.

V. Claims 28, 29, and 31, drawn to alfalfa feed derived from alfalfa plants having increased tannin levels and a method of increasing rumen by-pass of protein, classified in class 426, subclass 635, for example.

The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05 (h)). These inventions are distinct because Invention I can be used in a materially different process, such as a method for producing feed for a ruminant population. Furthermore, searching the invention of group I together with the invention of group II would impose a serious search burden. In the instant case, prior art searches of an alfalfa plant are not coextensive with prior art searches of methods of producing alfalfa plants with detectable levels of condensed tannins by identifying said plants and crossing said plants with other alfalfa plants. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and II together.

Inventions I and III-IV are patently distinct products. Inventions I and III-IV are drawn to separate and unique alfalfa plants having a unique genetic background that is

different from that of any other alfalfa plant. Furthermore, searching the invention of group I together with the invention of groups III-IV would impose a serious search burden. In the instant case, prior art searches of an alfalfa plant are not coextensive with prior art searches of specific alfalfa germplasm and regenerable cells of said germplasm. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and III-IV together.

Inventions I and V are patentably distinct products. Invention I is drawn to an alfalfa plant with its own unique genetic, morphological, and physiological characteristics that could be used, for example, as a cover crop. Invention V is drawn to feed to be given to animals derived from one or more alfalfa plants, wherein said plants have been processed in a manner that would make them suitable for animal feed. Furthermore, searching the invention of group I together with the invention of group V would impose a serious search burden. In the instant case, prior art searches of an alfalfa plant are not coextensive with prior art searches for animal feed. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a

serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and V together.

Inventions II and III-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05 (h)). These inventions are distinct because Inventions III-IV can be used in a materially different process, such as a method for producing alfalfa plants with increased yield. The process of Group II can also be practiced with a distinctly different alfalfa plant. Furthermore, searching the invention of group II together with the invention of groups III-IV would impose a serious search burden. In the instant case, prior art searches of a method of producing alfalfa plants with detectable levels of condensed tannins are not coextensive with prior art searches for alfalfa germplasm and regenerable cells of said germplasm. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions II and III-IV together.

Inventions II and V are unrelated. These inventions are distinct because Invention II is for producing further alfalfa plants, whereas Invention V is for feeding ruminants. Furthermore, searching the invention of group II together with the invention of group V would impose a serious search burden. In the instant case, prior art searches of a method of producing alfalfa plants with detectable levels of condensed tannins are not coextensive with prior art searches for animal feed. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions II and V together.

Inventions III and IV are patently distinct products. Inventions IIII and IV are drawn to a separate and unique alfalfa germplasm having a unique genetic background that is different from that of any other alfalfa germplasm. Furthermore, searching the invention of group III together with the invention of group IV would impose a serious search burden. In the instant case, prior art searches of alfalfa germplasm designated CW 28061 and regenerable cells of said germplasm are not coextensive with prior art searches for alfalfa germplasm designated CW 29053 and regenerable cells of said germplasm. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated

prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions III and IV together.

Inventions III-IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Inventions III-IV and V are unrelated because they have different functions. Inventions III-IV are drawn to an alfalfa germplasm, each with its own unique genetic, morphological, and physiological characteristics that could be used, for example, as a cover crop. Invention V is drawn to alfalfa feed derived from one or more alfalfa plants, wherein said plants have been processed in a manner that would make them suitable for animal feed. Furthermore, searching the invention of groups III-IV together with the invention of group V would impose a serious search burden. In the instant case, prior art searches of alfalfa germplasm and regenerable cells of said germplasm are not coextensive with prior art searches for animal feed. Search of each of these inventions would require different key word searches of each group using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions III-IV and V together.

Because the inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, Ph.D. can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 12, 2005

KOR

ASHWIN D. MEHTA, PH.D.
PRIMARY EXAMINER